

ESTTA Tracking number: **ESTTA169896**

Filing date: **10/19/2007**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92047819
Party	Defendant Powder
Correspondence Address	Powder 500 West Madison Street, Suite 2910 Chicago, IL 60661 UNITED STATES
Submission	Response to Board Order/Inquiry
Filer's Name	Jennifer L. Jolley
Filer's e-mail	jjolley@schwabe.com, trademarks@schwabe.com, apentheny@schwabe.com
Signature	/jennifer l jolley/
Date	10/19/2007
Attachments	Wexler TTAB response_001.pdf (4 pages)(124060 bytes) Wexler TTAB jolley dec_001.pdf (23 pages)(1076961 bytes) Wexler TTAB Wexler Dec.pdf (23 pages)(3634899 bytes) cert of service resp_001.pdf (1 page)(19825 bytes)

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4 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

5 In the matter of trademark Cancellation No. 920,047,819
6 For the mark POWDER + Design
Registration No. 2,843,001

7 PAUL STUART INC.,

8 Petitioner,

9 vs.

10 POWDER,

11 Registrant.

Cancellation No. 92047819

12 RESPONSE TO ORDER TO SHOW
13 CAUSE

14 **Response to Order to Show Cause why Default Should Not be Entered**

15 Grace Wexler, owner by assignment of the registration in this proceeding, respectfully
16 requests that the Trademark Trial and Appeal Board ("Board") decline to enter a default
17 judgment and accept Registrant's answer, filed concurrently with this Response. Ms. Wexler
18 had no notice of this Cancellation proceeding until after the due date for filing an answer and
19 after the Board's September 22, 2006 Order to Show Cause was issued. Through no fault of her
20 own, Ms. Wexler could not have responded earlier; she can demonstrate good cause for the late
21 filing of her Answer.

22 The POWDER + Design mark was registered to Powder, an Illinois limited liability
23 company (inadvertently identified in the application only as Powder rather than Powder, LLC).
24 Wexler Decl., ¶ 2. Powder, LLC was administratively dissolved by the Illinois Secretary of
25 State on June 30, 2006. *Id.* at ¶ 3. Powder, LLC has assigned the POWDER + Design mark
26

RESPONSE TO ORDER TO SHOW CAUSE - 1

SCHWABE, WILLIAMSON & WYATT, P.C.
Attorneys at Law
US Bank Centre
1420 5th Ave., Suite 3010
Seattle, WA 98101
Telephone 206.622.1711

1 and the registration therefor to Ms. Wexler. Wexler Decl., ¶ 2, Ex. A. The assignment has been
2 submitted for recordation with the Assignment Services Division of the PTO. Declaration of
3 Jennifer L. Jolley ("Jolley Decl."), ¶ 2.

4 The Notice of Cancellation was sent to the address on record with the PTO, which was
5 the registered agent of Powder LLC. *Id.* at ¶ 4. The registered agent, and former attorney, for
6 the dissolved LLC did receive the Petition for Cancellation, but neither gave the Cancellation
7 documents to Grace Wexler nor informed her of the Cancellation action. Wexler Decl., ¶ 5.
8 The first indication Ms. Wexler had of any proceedings regarding the POWDER & Design
9 registration occurred after the issuance of the Order to Show Cause why judgment of default
10 should not be entered against Powder. *Id.* at ¶ 5. Since receiving notice of this action, Grace
11 Wexler has acted diligently by procuring new counsel, preparing an answer, and responding to
12 the Order to Show Cause. Wexler Decl., ¶ 6.

13 The courts and the Board are reluctant to grant judgments by default and tend to resolve
14 doubt in favor of setting aside a default, since the law favors deciding cases on their merits.
15 *Paolo's Associates Ltd. Partnership v. Bodo*, 21 USPQ2d 1899, 1902 (quoting *Morris v.*
16 *Charnin*, 85 F.R.D. 689 (S.D.N.Y. 1980). In addition, where it is the attorney rather than the
17 party itself that is responsible for the failure to properly defend an action, courts are likely to
18 vacate a default. *Id.* (quoting *Trust Company Bank v. Tingen-Millford Drapery Company Inc.*,
19 119 F.R.D. 21,22 (E.D.N.C. 1987).

20 The standard for determining whether default judgment should be entered against a
21 respondent for failing to file a timely answer is set forth in Fed. R. Civ. P. 55(c). (*See also*
22 Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 312); *Fred Hayman*
23
24
25
26

1 *Beverly Hills Inc. v. Jacques Bernier Inc.*, 21 USPQ2d 1556, 1557 (TTAB 1991). The rule
2 states:

3 For **good cause** shown the court may set aside an entry of default and, if a
4 judgment by default has been entered, may likewise set it aside in accordance
5 with Rule 60(b). (Emphasis added).

6
7 F. R. Civ. P. 55(c).

8 “Good cause is usually found to have been established if the delay in the filing is not
9 the result of willful conduct or gross neglect on the part of the defendant, if the delay will not
10 result in substantial prejudice to the plaintiff, and if the defendant has a meritorious defense.”

11 *Hayman*, 21 USPQ2d at 1557. For example, good cause was demonstrated in *Hayman* when
12 counsel inadvertently failed to file an answer before leaving for vacation. Because the delay
13 was not the result of willful conduct or gross neglect, the plaintiff’s answer was accepted. *Id.*

14 Similarly, the Respondent’s delay is the result of another’s inaction and is not a result of
15 willful conduct or gross neglect. Grace Wexler was not informed of the Petition for
16 Cancellation by the former attorney and registered agent of the dissolved LLC, who was not
17 authorized to act on her behalf or on behalf on the dissolved company. No party demonstrated
18 willful conduct to delay the proceedings. Ms. Wexler has demonstrated good cause for the
19 delay.
20

21 Furthermore, a delay of less than two months will not result in substantial prejudice to
22 the Petitioner. At the time this Cancellation proceeding was filed and at the time Wexler’s
23 answer was due, Petitioner’s new application for the mark SILKY POWDER had not yet been
24 examined and thus, Wexler’s registration had not yet been cited against that application. Jolley
25 Decl., ¶ 3. Wexler’s Registration for the mark POWDER & Design was just cited against
26

RESPONSE TO ORDER TO SHOW CAUSE - 3

SCHWABE, WILLIAMSON & WYATT, P.C.
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Seattle, WA 98101
Telephone 206.622.1711

1 Petitioner's application on October 15, 2007. *Id.* at ¶ 4. Given the procedural posture of
2 Petitioner's application, this short delay is not substantially prejudicial under these
3 circumstances.

4 Even a six month delay has been held not substantially prejudicial. *See Delorme*
5 *Publishing Co. v. Eartha's Inc.*, 60 USPQ2d 1222, 1224 (TTAB 2001). In *Delorme*, the
6 applicant received notice of opposition and elected not to take action for six months. The
7 opposer could not demonstrate substantial prejudice despite the six months of lapsed time. *Id.*
8 Here, the short delay of less than two months is also insufficient to show substantial prejudice
9

10 Finally, as shown in the answer filed contemporaneously with this Response and in the
11 Declaration of Grace Wexler, Ms. Wexler has a meritorious defense. She has not abandoned
12 the POWDER & Design mark. Good cause having been demonstrated, a default judgment is
13 not appropriate in this case. Ms. Wexler should be permitted to defend this action on the merits
14 and her Answer accepted.
15

16 Respectfully submitted this 19th day of October, 2007.

17 Respectfully submitted,

18 SCHWABE, WILLIAMSON & WYATT, P.C.

19
20 

21 Jennifer L. Jolley
22 1420 Fifth Avenue, Suite 3010
23 Seattle, Washington 98101
24 Tel: 206-622-1711
25 Fax: 206-292-0460
26 Email: trademarks@schwabe.com;
jjolley@schwabe.com
Attorneys for Registrant

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4 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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5 In the matter of trademark Cancellation No. 920,047,819
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Registration No. 2,843,001

7 PAUL STUART, INC.,

8 Petitioner,

9 vs.

10 POWDER,

11 Registrant.

Cancellation No. 92047819

DECLARATION OF JENNIFER L.
JOLLEY

12
13 I, Jennifer L. Jolley, declare:

14 1. I make this declaration based on personal knowledge, and I am otherwise fully
15 competent to testify to the matters set forth herein.

16 2. Attached hereto as Exhibit A is a true and correct copy of the Electronic
17 Trademark Assignment System (ETAS) Confirmation Receipt.

18 3. Attached hereto as Exhibit B is a true and correct copy of the TARR record
19 available on the Patent and Trademark Office website for trademark application Serial No.
20 77/229,044 for the mark SILKY POWDER.

21 4. Attached hereto as Exhibit C is a true and correct copy of the office action dated
22 October 15, 2007 for trademark application Serial No. 77/229,044 for the mark SILKY
23 POWDER and available on the Patent and Trademark Office website.

24 The undersigned being warned that willful false statements and the like are
25 punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful
26

DECLARATION OF JENNIFER L. JOLLEY - 1

SCHWABE, WILLIAMSON & WYATT, P.C.
Attorneys at Law
US Bank Centre
1420 5th Ave., Suite 3010
Seattle, WA 98101
Telephone 206.622.1711

1 false statements and the like may jeopardize the validity of the application or document or
2 any registration resulting therefrom, declares that all statements made of his/her own
3 knowledge are true; and all statements made on information and belief are believed to be
4 true.

5 Dated this 19th day of October, 2007.

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7 Jennifer L. Jolley
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DECLARATION OF JENNIFER L. JOLLEY - 2

SCHWABE, WILLIAMSON & WYATT, P.C.
Attorneys at Law
US Bank Centre
1420 5th Ave., Suite 3010
Seattle, WA 98101
Telephone 206.622.1711

Exhibit A

Jolley, Jennifer L.

From: etas-server@uspto.gov
Sent: Friday, October 19, 2007 2:38 PM
To: Jolley, Jennifer L.
Subject: Assignment confirmation receipt ID:TM97649

Attachments: EASTM97649.html



EASTM97649.html
(5 KB)

ELECTRONIC TRADEMARK ASSIGNMENT SYSTEM (ETAS) CONFIRMATION RECEIPT

The USPTO has received a Trademark Assignment submitted through the Electronic Trademark Assignment System (ETAS). This is the only acknowledgement of receipt that will be transmitted for this ETAS submission. The submission may not be recalled.

After review by Assignment Services Division personnel a Notice of Recordation/Non-Recordation will be returned via fax. USPTO will attempt to fax to the number provided in the submission; fax failures will be delivered via US Postal Service to the Correspondence Address provided in the submission.

If a communication from the Assignment Services Division has not been received within 60 days of your confirmation receipt contact the Assignment Services Division Customer Service Desk at 571-272-3350 or send an e-mail to etas@uspto.gov.

If you have a technical question, comment or concern about your ETAS submission call 571-272-3350 during business hours or e-mail to etas@uspto.gov. Please have your ETAS receipt ID which is 'EASTM97649' available when calling or writing for assistance.

A printable version of the Confirmation Receipt is attached to this e-mail.

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Electronic Assignment Server at <http://etas.uspto.gov>

## TRADEMARK ASSIGNMENT

Electronic Version v1.1

Stylesheet Version v1.1

|                                                                                      |                           |                |                                        |
|--------------------------------------------------------------------------------------|---------------------------|----------------|----------------------------------------|
| SUBMISSION TYPE:                                                                     | NEW ASSIGNMENT            |                |                                        |
| NATURE OF CONVEYANCE:                                                                | NUNC PRO TUNC ASSIGNMENT  |                |                                        |
| EFFECTIVE DATE:                                                                      | 06/30/2006                |                |                                        |
| CONVEYING PARTY DATA                                                                 |                           |                |                                        |
| Name                                                                                 | Formerly                  | Execution Date | Entity Type                            |
| Powder LLC                                                                           |                           | 10/18/2007     | LIMITED LIABILITY<br>COMPANY: ILLINOIS |
| RECEIVING PARTY DATA                                                                 |                           |                |                                        |
| Name:                                                                                | Grace Wexler              |                |                                        |
| Street Address:                                                                      | 3412 Halderman Street     |                |                                        |
| City:                                                                                | Los Angeles               |                |                                        |
| State/Country:                                                                       | CALIFORNIA                |                |                                        |
| Postal Code:                                                                         | 90066                     |                |                                        |
| Entity Type:                                                                         | INDIVIDUAL: UNITED STATES |                |                                        |
| PROPERTY NUMBERS Total: 1                                                            |                           |                |                                        |
| Property Type                                                                        | Number                    | Word Mark      |                                        |
| Registration Number:                                                                 | 2843001                   | POWDER         |                                        |
| CORRESPONDENCE DATA                                                                  |                           |                |                                        |
| Fax Number:                                                                          | (206)292-0460             |                |                                        |
| <i>Correspondence will be sent via US Mail when the fax attempt is unsuccessful.</i> |                           |                |                                        |
| Phone:                                                                               | 206-622-1711              |                |                                        |
| Email:                                                                               | jjolley@schwabe.com       |                |                                        |
| Correspondent Name:                                                                  | Jennifer L Jolley         |                |                                        |
| Address Line 1:                                                                      | 1420 Fifth Ave, Ste 3010  |                |                                        |
| Address Line 4:                                                                      | Seattle, WASHINGTON 98101 |                |                                        |

|                                                                                                    |                     |
|----------------------------------------------------------------------------------------------------|---------------------|
| ATTORNEY DOCKET NUMBER:                                                                            | WEXLER / POWDER     |
| NAME OF SUBMITTER:                                                                                 | Jennifer L. Jolley  |
| Signature:                                                                                         | /jennifer l jolley/ |
| Date:                                                                                              | 10/19/2007          |
| Total Attachments: 2<br>source=Assignment#page1.tif<br>source=Assignment#page2.tif                 |                     |
| <b>RECEIPT INFORMATION</b><br><br>ETAS ID: TM97649<br>Receipt Date: 10/19/2007<br>Fee Amount: \$40 |                     |

# Exhibit B



**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2007-10-19 18:31:18 ET**

**Serial Number:** 77229044 [Assignment Information](#)

[Trademark Document Retrieval](#)

**Registration Number:** (NOT AVAILABLE)

**Mark**

**SILKY POWDER**

**(words only):** SILKY POWDER

**Standard Character claim:** Yes

**Current Status:** A non-final action has been mailed. This is a letter from the examining attorney requesting additional information and/or making an initial refusal. However, no final determination as to the registrability of the mark has been made.

**Date of Status:** 2007-10-15

**Filing Date:** 2007-07-13

**Transformed into a National Application:** No

**Registration Date:** (DATE NOT AVAILABLE)

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 107

**Attorney Assigned:**  
KAJUBI ELIZABETH N [Employee Location](#)

**Current Location:** L7X -TMEG Law Office 107 - Examining Attorney Assigned

**Date In Location:** 2007-10-15

---

**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

1. Paul Stuart, Inc.

**Address:**  
Paul Stuart, Inc.  
Madison Avenue at 45th Street  
New York, NY 10017  
United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** New York

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**GOODS AND/OR SERVICES**

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**International Class:** 025

**Class Status:** Active

Clothing, namely, suits, pants, skirts, and jackets

**Basis:** 1(a)

**First Use Date:** 2003-07-15

**First Use in Commerce Date:** 2003-07-15

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**ADDITIONAL INFORMATION**

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(NOT AVAILABLE)

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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2007-10-15 - Notification Of Non-Final Action E-Mailed

2007-10-15 - Non-final action e-mailed

2007-10-15 - Non-Final Action Written

2007-10-08 - Amendment to Use approved

2007-09-29 - Assigned To Examiner

2007-08-29 - Amendment to use processing complete

2007-08-29 - Amendment to Use filed

2007-08-28 - TEAS Amendment of Use Received

2007-07-18 - New Application Entered In Tram

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**ATTORNEY/CORRESPONDENT INFORMATION**

---

**Attorney of Record**

Laura J. Winston, Paul Fields, Karin Segall, Andrew Baum, Robert S. Weisbein, Eric Prager, Amy J. Benjamin, Abigail R. Rubinstein and Kathryn Starnella

**Correspondent**

Laura J. Winston, Paul Fields, Karin Seg

DARBY & DARBY P.C.

P.O, BOX 770, Church Street Station

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=77229044>

NEW YORK NY 10008-0770

Phone Number: 212.527.7700

Fax Number: 212.527.7701

---

# Exhibit C

to: Paul Stuart, Inc. (tmdocket@darbylaw.com)  
subject: TRADEMARK APPLICATION NO. 77229044 - SILKY POWDER - 06082/300K62  
sent: 10/15/2007 11:46:22 AM  
sent As: ECOM107@USPTO.GOV  
attachments: Attachment - 1  
Attachment - 2  
Attachment - 3  
Attachment - 4  
Attachment - 5  
Attachment - 6  
Attachment - 7

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 77/229044

**MARK:** SILKY POWDER

**\*77229044\***

**CORRESPONDENT ADDRESS:**

Laura J. Winston, Paul Fields, Karin Seg  
DARBY & DARBY P.C.  
P.O, BOX 770, Church Street Station  
NEW YORK NY 10008-0770

**RESPOND TO THIS ACTION:**

<http://www.uspto.gov/teas/eTEASpageD.htm>

**GENERAL TRADEMARK INFORMATION:**

<http://www.uspto.gov/main/trademarks.htm>

**APPLICANT:** Paul Stuart, Inc.

**CORRESPONDENT'S REFERENCE/DOCKET**

**NO:**

06082/300K62

**CORRESPONDENT E-MAIL ADDRESS:**

tmdocket@darbylaw.com

**OFFICE ACTION**

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION  
WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

**ISSUE/MAILING DATE:** 10/15/2007

the assigned trademark examining attorney has reviewed the referenced application and has determined the following:

### SECTION 2(d) - LIKELIHOOD OF CONFUSION REFUSAL

Registration of the proposed mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 343001. Trademark Act Section 2(d), 15 U.S.C. §1052(d); TMEP §§1207.01 *et seq.* See the enclosed registration.

Likelihood of confusion determination in this case involves a two-part analysis. First, the marks are compared for similarities in appearance, sound, connotation and commercial impression. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Second, the goods or services are compared to determine whether they are similar or related or whether the activities surrounding their marketing are such that confusion as to origin is likely. *In re National Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984); *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re Int'l Tel. and Tel. Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Prods. Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); TMEP §§1207.01 *et seq.*

In the instant case, applicant proposes the mark “**SILKY POWDER**” for “clothing, namely, suits, pants, skirts, and jackets.” The registered mark is “**POWDER**” (plus design) for “clothing, namely, suits, pants, skirts, and jackets.”

### COMPARISON OF THE GOODS

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. Instead, they need only be related in some manner, or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Prods. Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re Int'l Tel. & Tel. Corp.*, 197 USPQ 910 (TTAB 1978); TMEP §1207.01(a)(i).

Applicant's goods are similar to those of the registrant's, as both parties identify their goods as clothing. The decisions in the clothing field have held many different types of apparel to be related under Section 2(d). *Cambridge Rubber Co. v. Luett, Peabody & Co., Inc.*, 286 F.2d 623, 128 USPQ 549 (C.C.P.A. 1961) (“WINTER CARNIVAL” for women's boots, men's and boys' underwear); *Jockey Int'l, Inc. v. Mallory & Church Corp.*, 25 USPQ2d 1233 (TTAB 1992) (“ELANCI” for underwear v. “ELAAN” for neckties); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991) (“ESSENTIALS” for women's pants, blouses, shorts and jackets v. women's shoes); *In re Pix of America, Inc.*, 225 USPQ 691 (TTAB 1985) (“NEWPORTS” for women's shoes v. “NEWPORT” for outer shirts); *In re Mercedes Slacks, Ltd.*, 213 USPQ 397 (TTAB 1982) (“OMEGA” for hosiery v. trousers); *In re Cook United, Inc.*, 185 USPQ 444 (TTAB 1975) (“GRANADA” for men's suits, coats, and trousers v. ladies' pantyhose and hosiery); *Esquire Sportswear Mfg. Co. v. Genesco Inc.*, 141 USPQ 400 (TTAB 1964) (“SLEEX” for brassieres and girdles v. slacks for men and young men).

### COMPARISON OF THE MARKS

The marks are compared for similarities in sound, appearance, meaning or connotation. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1536 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *In re Mack*, 197 USPQ 755 (TTAB 1977); TMEP §1207.01(b).

Regarding the issue of likelihood of confusion, the question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods they identify come from the same source. *In re Westmint-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (C.C.P.A. 1972). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. *Recot, Inc. v. M.C. Becton*, 214 F.2d 1322, 54 USPQ2d 1894, 1890 (Fed. Cir. 1950); *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

The applicant's mark is highly similar in appearance, sound and connotation to the registered mark. Applicant's mark does not contain the design found in applicant's registrant's and adds the term "SILKY." However, this does not alter the commercial impression, as the mere addition of a term to a registered mark does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Section 2(d). *In re Chatam International Inc.*, 380 F.3d 1340, 54 USPQ2d 1944 (Fed. Cir. 2004) ("GASPAR'S ALE and 'JOSE GASPAR GOLD'"); *Coca-Cola Bottling Co. v. Joseph E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) ("BENGAL" and "BENGAL LANCER"); *Lilly v. Lititz, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) ("THE LILLY" and "LILLI ANN"); *In re Torito Rests. Inc.*, 9 USPQ2d 2002 (TTAB 1988) ("MACHO" and "MACHO COMBOS"); *In re United States Shoe Corp.*, 229 USPQ 707 (TTAB 1985) ("CAREER IMAGE" and "CREST CAREER IMAGES"); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) ("CONFIRM" and "CONFIRMCELLS"); *In re Riddle*, 225 USPQ 630 (TTAB 1985) ("ACCUTUNE" and "RICHARD PETTY'S ACCU TUNE"); *In re Cosvetic Laboratories, Inc.*, 202 USPQ 842 (TTAB 1979) ("HEAD START" and "HEAD START COSVETIC"); TMEP §1207.01(b)(iii). Therefore, because of the similarities between the marks and goods of the parties, a likelihood of confusion as to source of these goods must be found to exist.

Although the trademark-examining attorney has refused registration, applicant may respond to the refusal to register by submitting evidence and arguments in support of registration.

If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following requirements

#### **DISCLAIMER**

Applicant must disclaim "SILKY" apart from the mark as shown because it is merely descriptive of a feature of the goods and services that applicant will provide. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a). Specifically, SILKY is defined as "made of silk or a similar fiber or fabric." *Please see the attached dictionary definition.* In this case, it is presumed that applicant's clothing goods will be made of silk and therefore have a silky texture. As such "silky" is merely descriptive for a feature of the goods and services that applicant will provide.

The following is the accepted standard format for a disclaimer:

No claim is made to the exclusive right to use "SILKY" apart from the mark as shown.

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the signed trademark examining attorney directly at the number below.

/ekajubi/

Elizabeth N. Kajubi

Trademark Attorney

United States Patent and Trademark Office

Law Office 107


(571) 272-2727

**RESPOND TO THIS ACTION:** If there are any questions about the Office action, please contact the assigned examining attorney. A response to this Office action should be filed using the form available at <http://www.uspto.gov/teas/eTEASpageD.htm>. If notification of this Office action was received via e-mail, no response using this form may be filed for 72 hours after receipt of the notification. **Do not attempt to respond by e-mail as the SPTO does not accept e-mailed responses.**

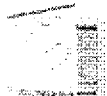
When responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.




**STATUS CHECK:** Check the status of the application at least once every six months from the initial filing date using the SPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.



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**silk·y**  [sil-kee] Pronunciation Key - Show IPA Pronunciation

—adjective, **silk·i·er**, **silk·i·est**.

1. of or like silk; smooth, lustrous, soft, or delicate: *silky skin*.
2. *Botany*. covered with fine, soft, closely set hairs, as a leaf.

[Origin: 1605-15; SILK + -y<sup>1</sup>]

—Related forms


**silk·i·ly**, adverb

**silk·i·ness**, noun

Dictionary.com Unabridged (v 1.1)

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**silk·y**  (sil'kē) Pronunciation Key

adj. **silk·i·er**, **silk·i·est**

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1. Resembling silk; lustrous. See Synonyms at [sleek](#).
2. Made of silk; silken.
3. Covered with or characterized by fine soft hairs or feathers: *a silky chick*.
4. Ingratiating; seductive: *spoke with silky plausibility*.

**silky** *adv.*, **silken** *n.*

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**silky**

*adjective*

having a smooth, gleaming surface reflecting light: "glossy auburn hair"; "satiny gardenia petals"; "sleek black fur"; "silken eyelashes"; "silky skin"; "a silklike fabric"; "slick seals and otters" [syn: [satiny](#)]

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**'silky** *adjective*

soft, fine and rather shiny like silk

Arabic: حروري

Chinese (Simplified): 丝一样的

Chinese (Traditional): 絲一樣

Czech: hedvábný

Danish: silkeagtig

Dutch: zijdeachtig

Estonian: siidpehme

Finnish: silkkinpehmeä

French: soyeux

German: seidig

Greek: μεταξένιος,  
απαλός

Hungarian: selymes

Icelandic: silki-, silkimjúkur

Indonesian: seperti sutera

Italian: setoso

Japanese: 絹のような

Korean: (비단처럼) 부드러운

Latvian: zīdains

Lithuanian: (švelnus) kaip  
šilkas

Norwegian: silke-, silkeglatt

Polish: jedwabisty

Portuguese (Brazil): sedoso

Portuguese (Portugal): sedoso

Romanian: mătăsoș

Russian: шелковистый

Slovak: hodvábný

Slovenian: svilen

Spanish: sedoso, suave

Swedish: silkeslen,  
silkesaktig,  
sidenklänsande

Turkish: ipek gibi

See also: [silkworm](#), [silk](#)

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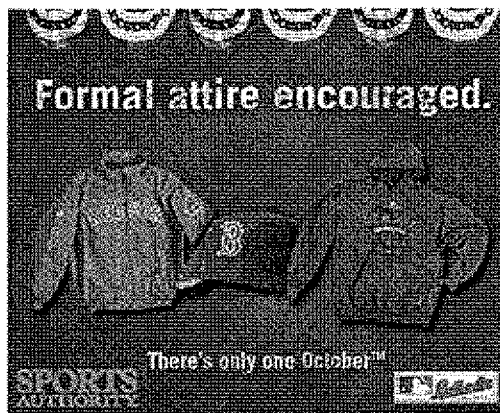
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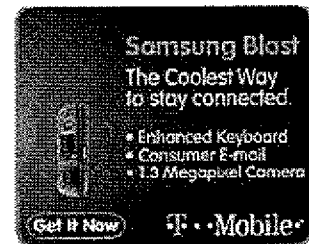
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Exhibit C, Page 8

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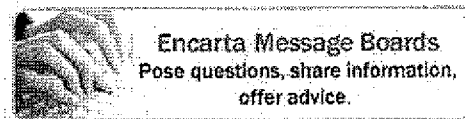
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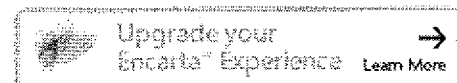


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Print: Oct 8, 2007

78200085

**DESIGN MARK**

**Serial Number**

78200085

**Status**

CANCELLATION PENDING

**Word Mark**

POWDER

**Standard Character Mark**

No

**Registration Number**

2843001

**Date Registered**

2004/05/18

**Type of Mark**

TRADEMARK

**Register**

PRINCIPAL

**Mark Drawing Code**

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

**Owner**

Powder LTD LIAB JT ST CO ILLINOIS 500 West Madison Street Suite 2910  
Chicago ILLINOIS 60661

**Goods/Services**

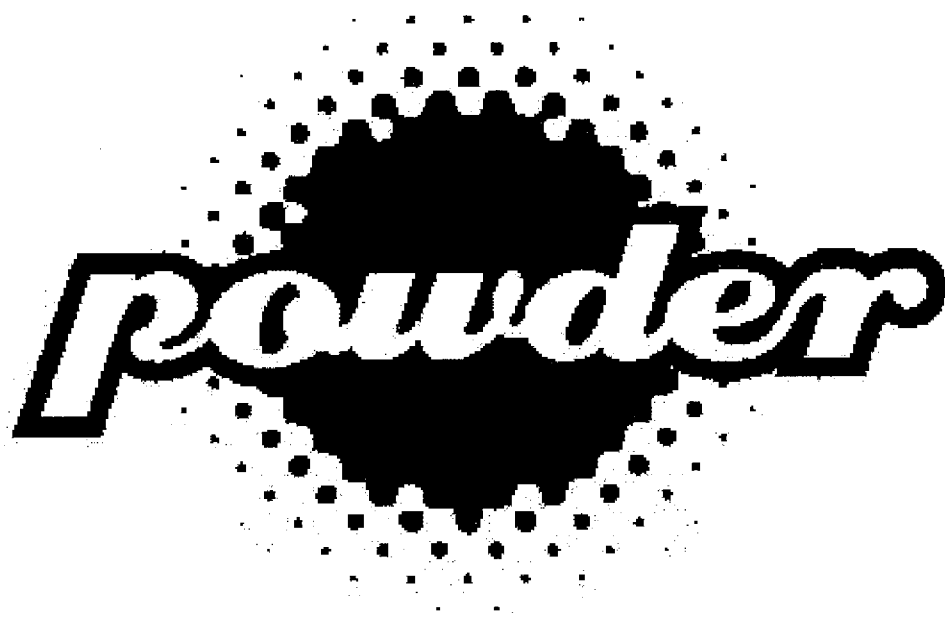
Class Status -- ACTIVE. IC 025. US 022 039. G & S: clothing, namely, underwear, undergarments, undershirts, underpants, thongs, t-shirts, pajamas, sleepwear, sleep shirts, socks, blouses, dresses, panties, pants, skirts, jackets, jeans, swimwear, sweatshirts and hats. First Use: 1999/07/01. First Use In Commerce: 1999/08/01.

**Filing Date**

2003/01/04

**Examining Attorney**

CASTRO, GIANCARLO



to: Paul Stuart, Inc. (tmdocket@darbylaw.com)  
subject: TRADEMARK APPLICATION NO. 77229044 - SILKY POWDER - 06082/300K62  
sent: 10/15/2007 11:46:24 AM  
sent As: ECOM107@USPTO.GOV  
attachments:

**IMPORTANT NOTICE**  
**USPTO OFFICE ACTION HAS ISSUED ON 10/15/2007 FOR**  
**APPLICATION SERIAL NO. 77229044**

Please follow the instructions below to continue the prosecution of your application:

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or copy and paste this URL into the address field of your browser), or visit [http://portal.uspto.gov/external/portal/tow?DDA=Y&serial\\_number=77229044&doc\\_type=OOA&mail\\_date=2007/10/15](http://portal.uspto.gov/external/portal/tow?DDA=Y&serial_number=77229044&doc_type=OOA&mail_date=2007/10/15)  
and enter the application serial number to **access** the Office action.

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1  
2  
3  
4 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

5 In the matter of trademark Cancellation No. 920,047,819  
6 For the mark POWDER + Design  
Registration No. 2,843,001

7 PAUL STUART, INC.,

8 Petitioner,

9 vs.

10 POWDER,

11 Registrant.

Cancellation No. 92047819

DECLARATION OF GRACE WEXLER  
IN SUPPORT OF RESPONSE TO ORDER  
TO SHOW CAUSE

12  
13 I, Grace Wexler, declare:

14 1. I make this declaration based on personal knowledge, and I am otherwise fully  
15 competent to testify to the matters set forth herein.

16 2. I am the owner of trademark Registration No 2,843,001 for the mark POWDER +  
17 Design. Attached hereto as Exhibit A is a true and correct copy of the assignment of the  
18 mark from Powder LLC.

19 3. I was the sole member of Powder LLC prior to its administrative dissolution by  
20 the Illinois Secretary of State on June 30, 2006.

21 4. At the time the Petition for Cancellation was filed, the address on file with Patent  
22 and Trademark Office for Registration No 2,843,001 was the address of the registered agent  
23 and former attorney for Powder LLC.

24 5. I was not informed of this cancellation proceeding until after the Order to Show  
25 Cause was issued. On or about October 4, 2007, the registered agent and former attorney for  
26

DECLARATION OF GRACE WEXLER - 1

SCHWABE, WILLIAMSON & WYATT, P.C.  
Attorneys at Law  
US Bank Centre  
1420 5th Ave., Suite 3010  
Seattle, WA 98101  
Telephone 206.622.1711

1 the dissolved company informed me of these proceedings and forwarded to me  
2 correspondence he had with Petitioner's counsel without my knowledge or authority.

3 6. Since learning of this action, I immediately sought new counsel to respond to the  
4 Order to Show Cause and prepare an answer.

5 7. Since August 1999, my POWDER & Design trademark has been in continuous  
6 use on clothing marketed and distributed throughout the United States and exported to  
7 Shanghai, China.

8 8. The POWDER & Design mark is used on all of the clothing items listed in the  
9 registration, except for swimwear. Our swimwear line will be launched in 2008.

10 9. Attached hereto as Exhibit B are true and correct photographs of POWDER brand  
11 clothing. Each item bears a label with the POWDER & Design trademark.

12 The undersigned being warned that willful false statements and the like are  
13 punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful  
14 false statements and the like may jeopardize the validity of the application or document or  
15 any registration resulting therefrom, declares that all statements made of his/her own  
16 knowledge are true; and all statements made on information and belief are believed to be  
17 true.

18 Dated this 19th day of October, 2007.

19  
20 /Grace Wexler/  
Grace Wexler

# Exhibit A

## TRADEMARK ASSIGNMENT

THIS TRADEMARK ASSIGNMENT is by and between Powder, LLC, an Illinois limited liability company (the "Assignor") and Grace Wexler, an individual (the "Assignee").

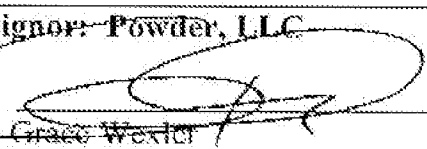
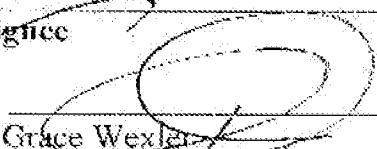
### RECITALS

- A. Assignor was the owner of the trademarks POWDER, POWDER + Design and United States trademark registration identified on the attached Schedule, along with the goodwill appurtenant thereto (the "POWDER Trademarks");
- B. Assignor's limited liability company dissolved on or about June 30, 2006. Upon dissolution, its assets, including the POWDER Trademarks, were transferred to its sole member, the Assignee.
- C. The parties desire to formalize Assignee's acquisition of the POWDER Trademarks.

### ASSIGNMENT

NOW THEREFORE, for good and valuable consideration, the receipt and sufficiency of which is hereby acknowledged, the parties agree:

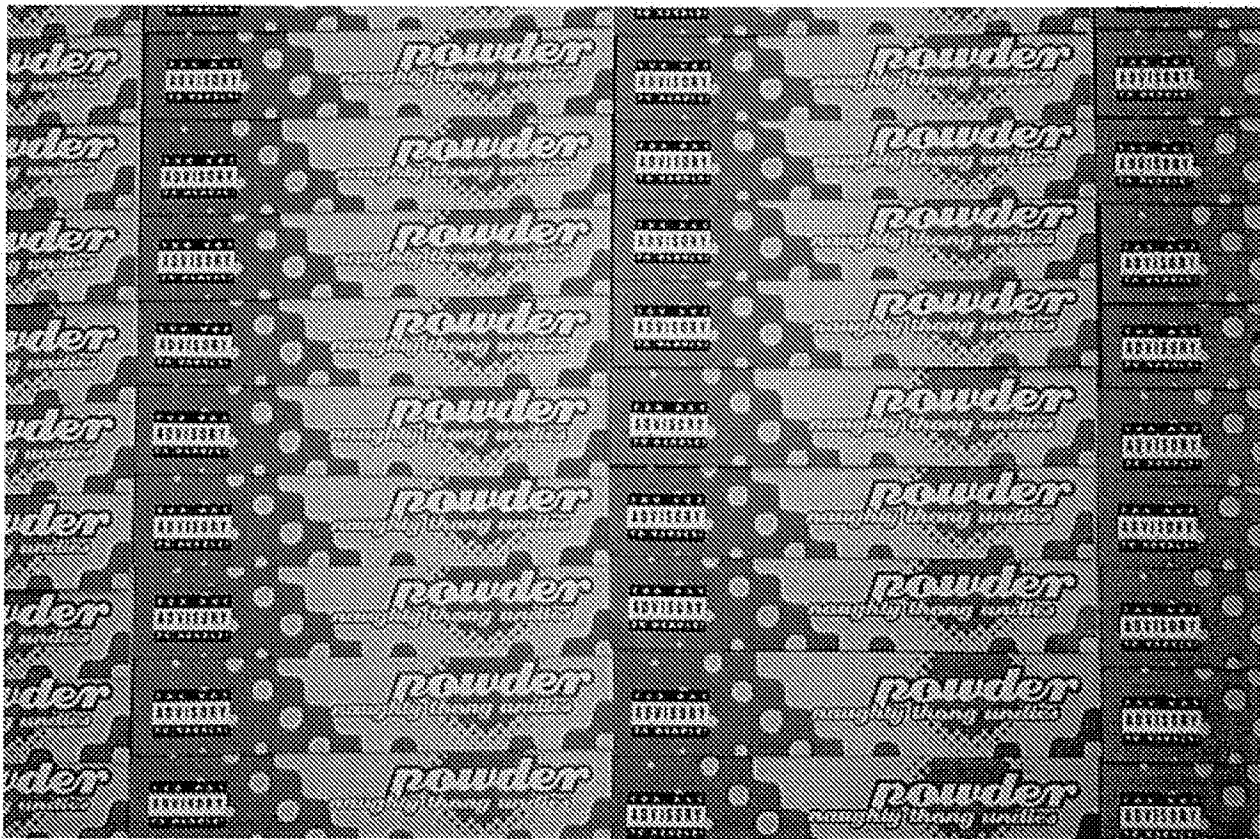
- 1. Assignor does hereby assign, transfer, and convey to Assignee, *nunc pro tunc* as of June 30, 2006, all right, title, and interest that Assignor may have acquired in and to the POWDER Trademarks, including:
  - (a) all goodwill of the business appertaining to and symbolized by the POWDER Trademarks;
  - (b) the right to sue and recover damages and profits for all past, present, and future infringement of the POWDER Trademarks by third parties; and
  - (c) the rights of Assignor in and to any registration of the POWDER Trademarks specified on the attached Schedule.
- 2. Assignor agrees to take all further actions reasonably requested by Assignee to effect the transfer intended by this Assignment.

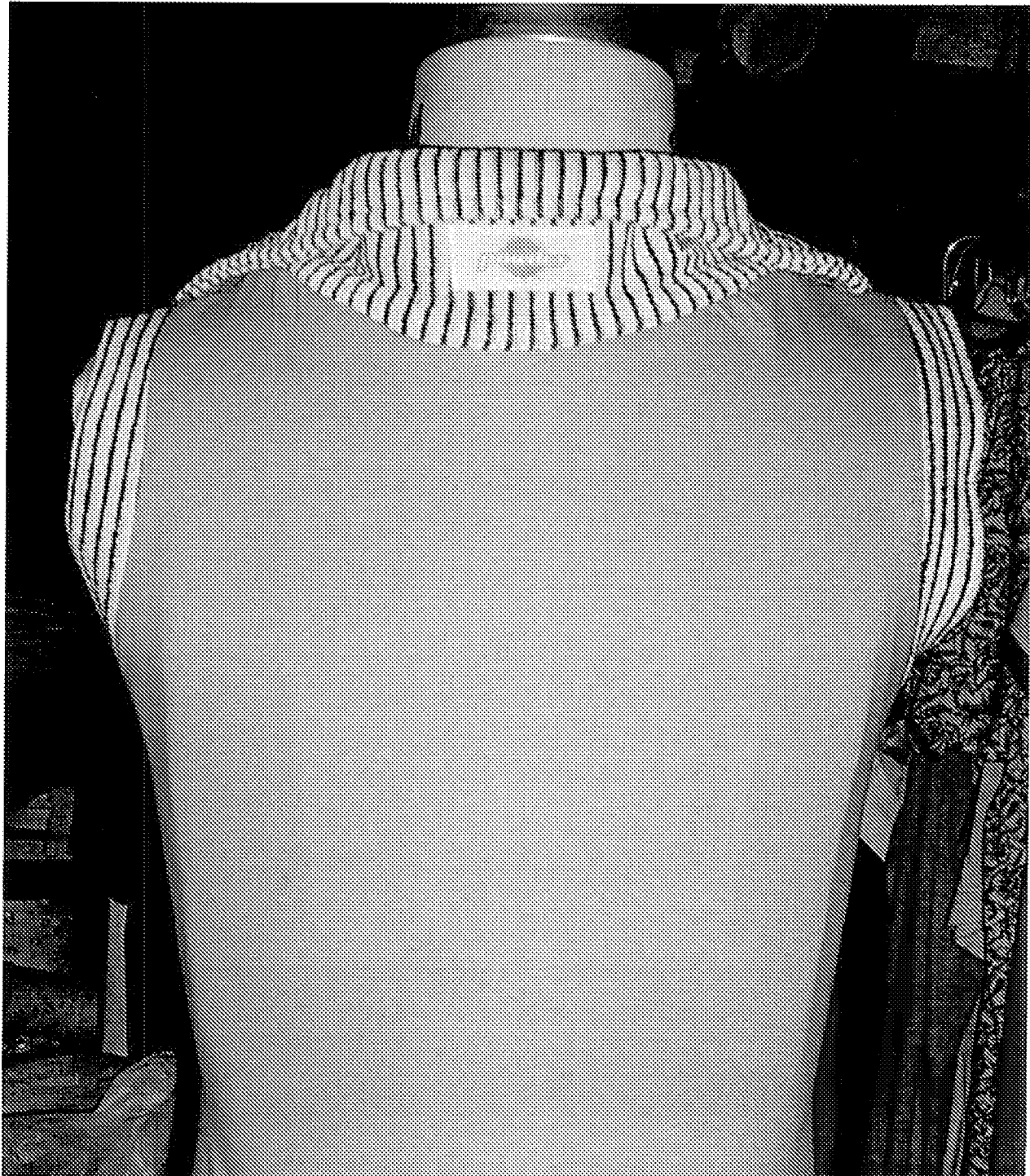
|                                                                                                                                                                                             |                                                                                                                                                       |
|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------|
| <b>Assignor: Powder, LLC</b><br>By: <br>Grace Wexler<br>Title: Managing Member<br>Date: October 18, 2007 | <b>Assignee</b><br>By: <br>Grace Wexler<br>Date: October 18, 2007 |
|---------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------|

## SCHEDULE OF REGISTRATIONS

| Trademark       | Registration No. | Application/<br>Registration Date                          |
|-----------------|------------------|------------------------------------------------------------|
| POWDER + DESIGN | 2,843,001        | Application Date: 1-4-2003<br>Registration Date: 5-18-2004 |

# Exhibit B

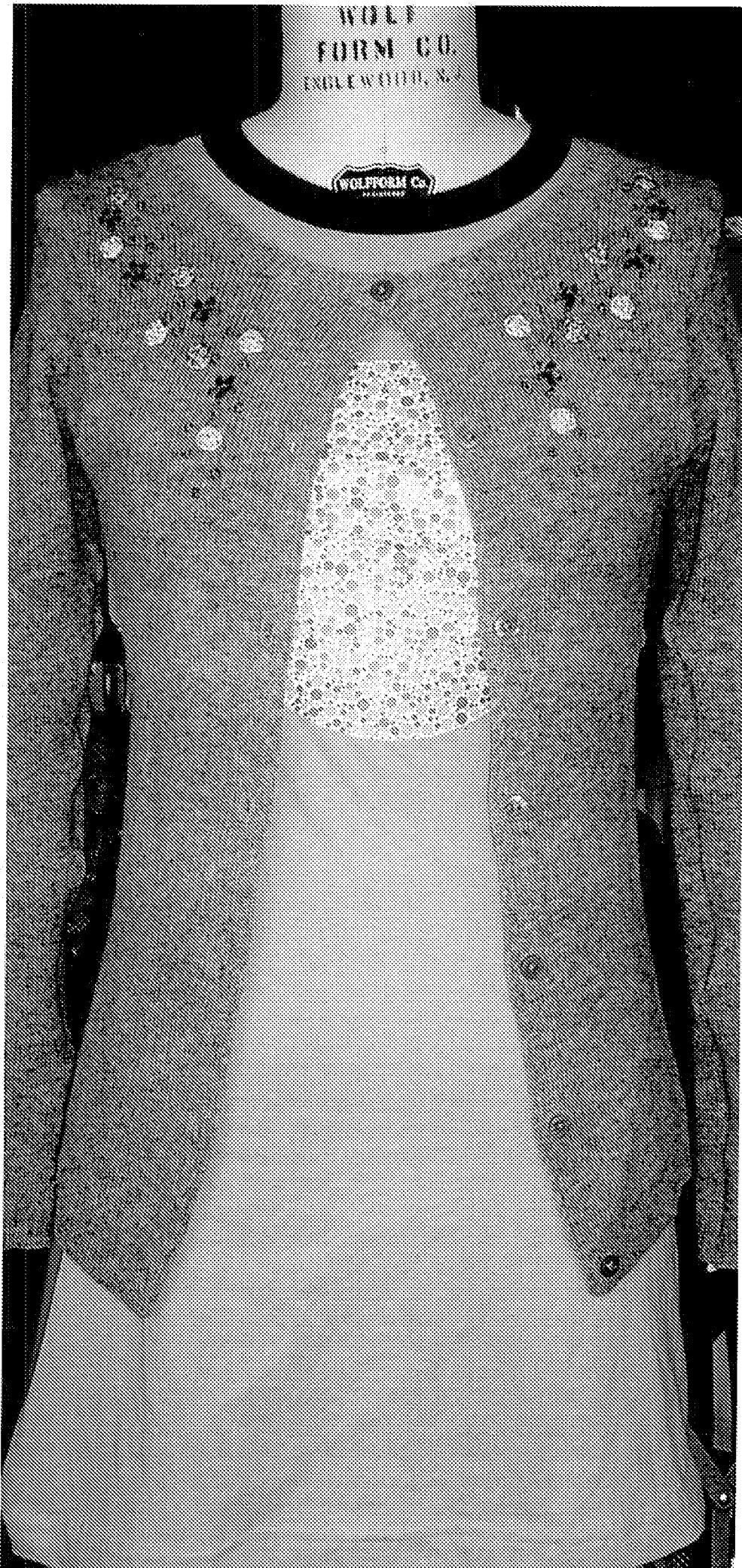






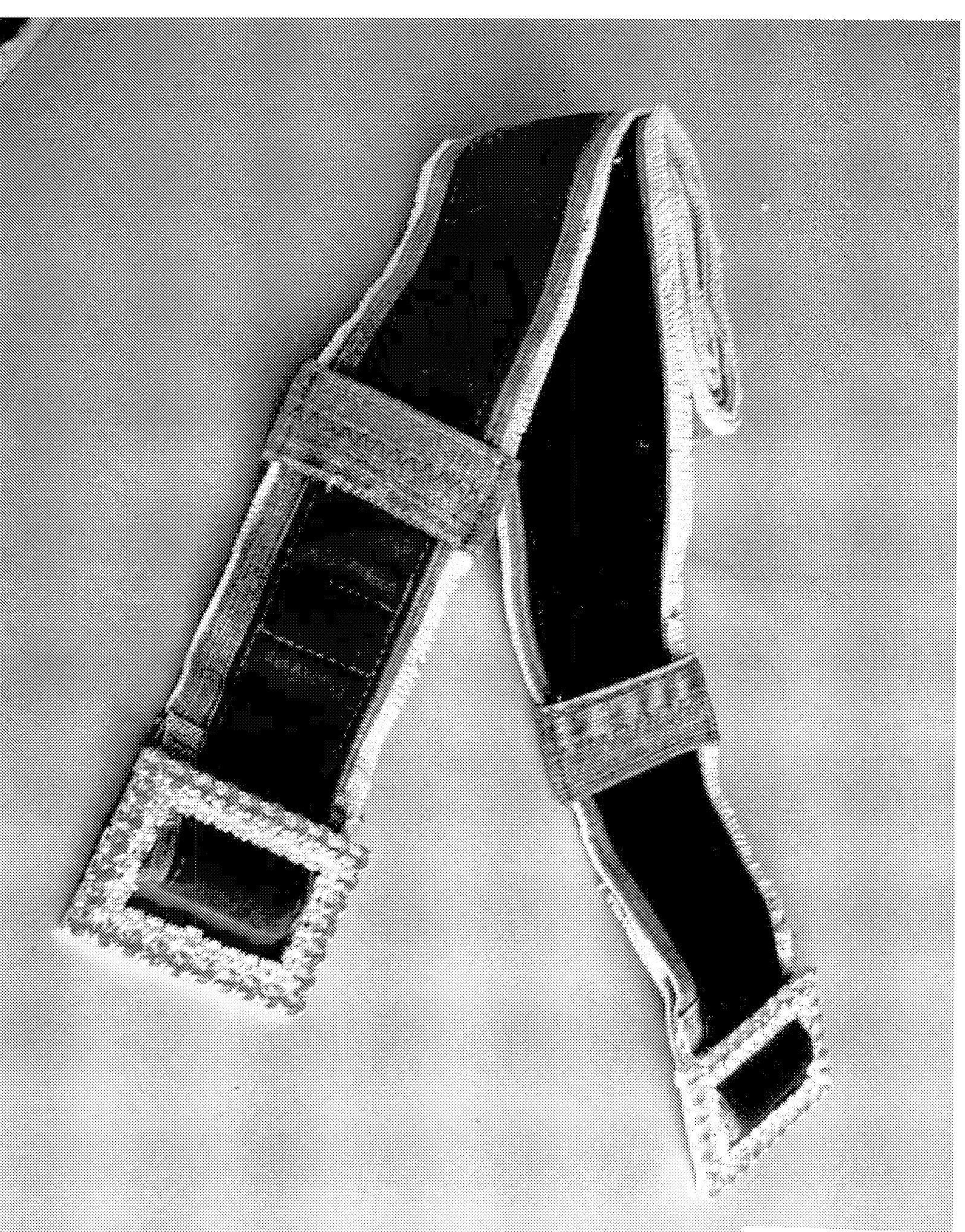








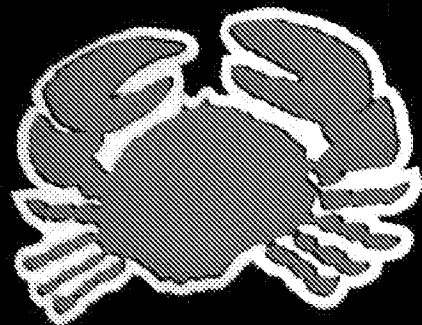


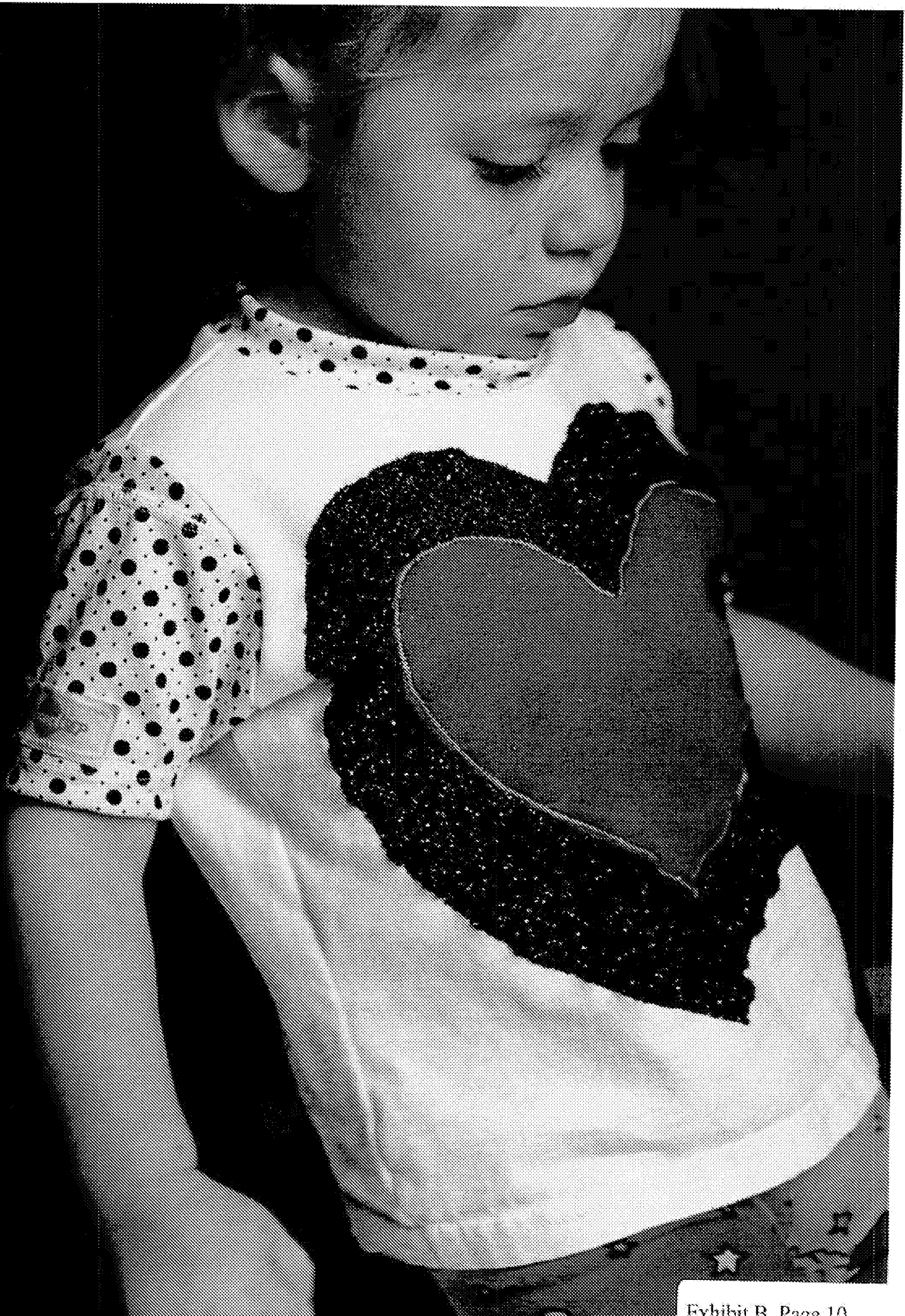






**BITE  
ME.**

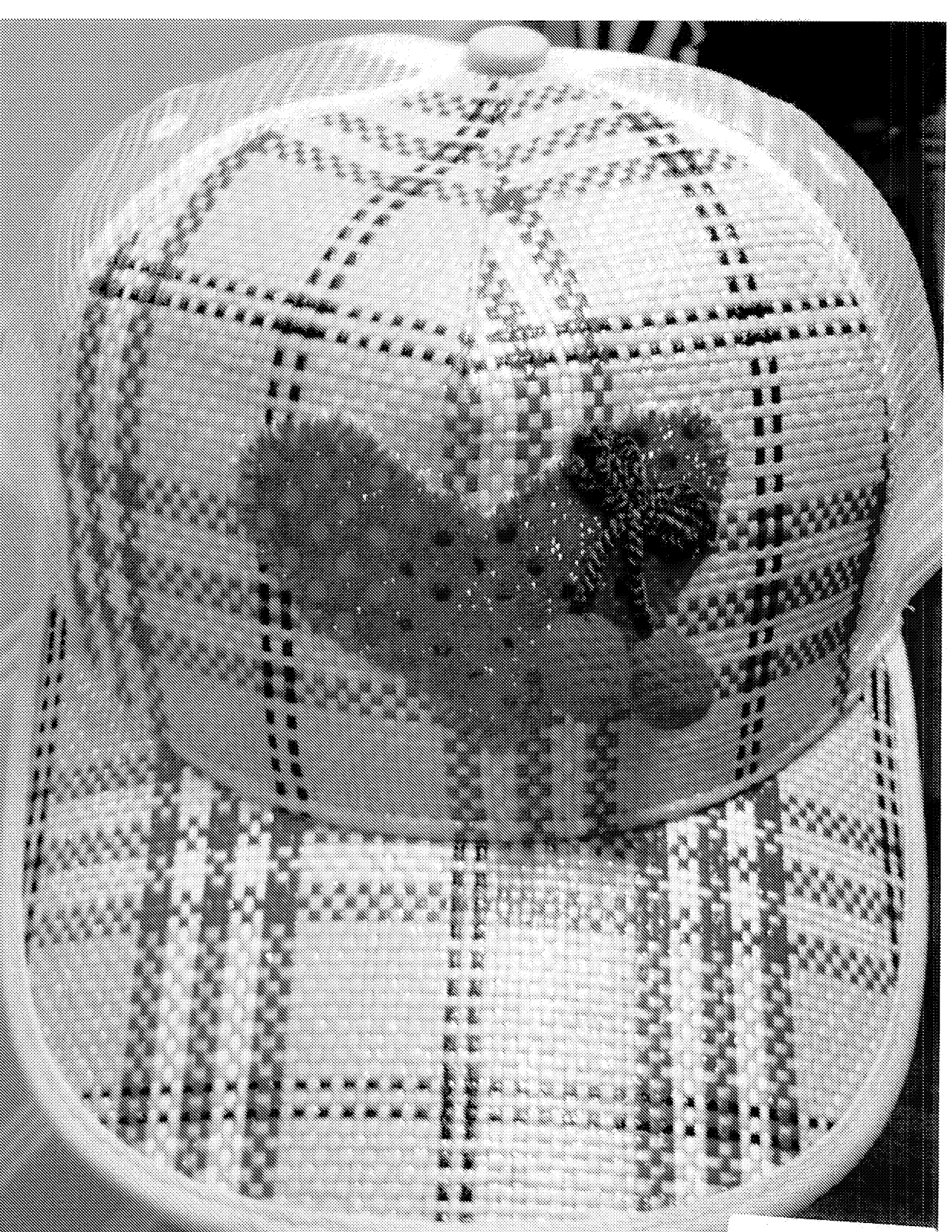














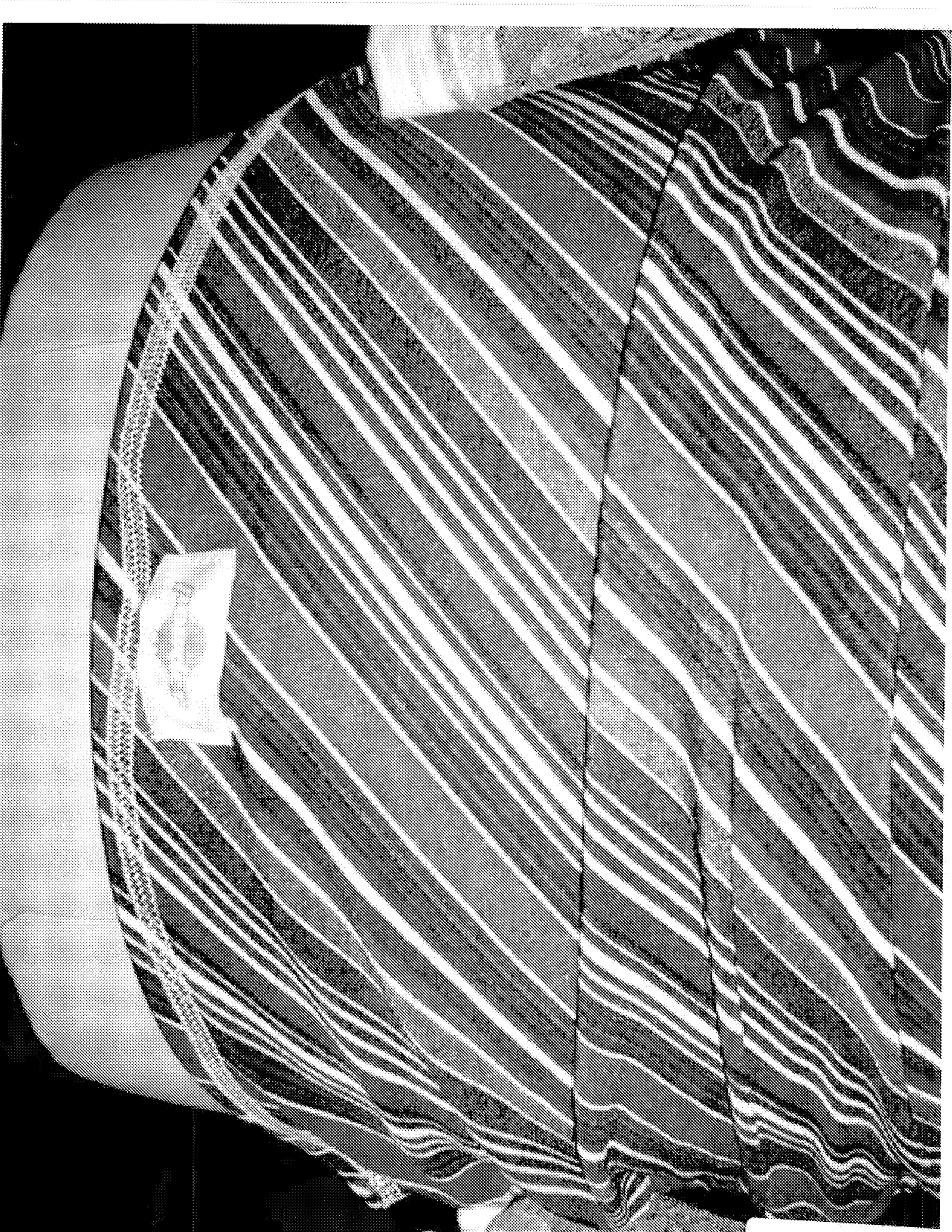
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*powder*

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3 IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
4 BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

5 In the matter of trademark Cancellation No. 92047819  
6 For the mark POWDER + Design  
7 Registration No. 2,843,001

8 PAUL STUART, INC.,

9 Petitioner,

10 vs.

11 POWDER,

12 Registrant.

Cancellation No. 92047819

CERTIFICATE OF SERVICE

13 CERTIFICATE OF SERVICE

14 On October 19, 2007, I caused a true copy of Registrant's RESPONSE TO ORDER  
15 TO SHOW CAUSE, DECLARATION OF GRACE WEXLER IN SUPPORT OF  
16 RESPONSE TO ORDER TO SHOW CAUSE, and DECLARATION OF JENNIFER L.  
17 JOLLEY to be served via U.S. First Class Mail, with postage thereon fully prepaid, to the  
18 following counsel of record:

19 Laura J. Winston  
20 Attorney at Law  
21 Darby & Darby P.C.  
22 PO Box 770  
23 Church Street Station  
24 New York, NY 10008-0770

25 /Jennifer L. Jolley/

26 Jennifer L. Jolley

SCHWABE, WILLIAMSON & WYATT, P.C.  
Attorneys at Law  
US Bank Centre  
1420 5th Ave., Suite 3010  
Seattle, WA 98101  
Telephone 206.622.1711